

### REMARKS

This is intended as a full and complete response to the Office Action dated April 20, 2004, having a shortened statutory period for response set to expire on July 20, 2004. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-24 are pending in the application. Claims 1-30 remain pending following entry of this response, of which claims 10-24 are allowed. Claims 1-2 and 5-6 have been amended. New claims 25-30 have been added to recite aspects of the invention. Applicants submit that the amendments and new claims do not introduce new matter. Rather, the new claims 25-30 correspond to objected to claims 3, 4, 6, 8 and 9, respectively, rewritten in independent form.

Claims 1, 2, 5 and 7 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Baisley* (US 6,502,112). Applicant respectfully traverses the rejection.

*Baisley* is directed to a method for comparing two XML-based XML documents for identical content. The method begins with the step of parsing each of the documents to create a semantic graph of each documents' objects. (See, Abstract.) The Examiner suggests that the step of parsing the documents in *Baisley* is the same as invoking the specific data retrieval method in the present invention. The Applicant respectfully points out that the parsing performed in *Baisley* involves reading an XML document and creating a graph of its objects. (See Col. 4, lines 47-49.) This is done in *Baisley* so that in comparing two XML documents that are semantically identical, they are returned as equal, even if some semantically identical objects are located in different orders in the two documents. The tool in *Baisley* achieves this by parsing the documents, graphing their objects, sorting of the values of the objects that do not have a significant order, and comparing the resultant graphs. The specific data retrieval method of the present invention is invoked, however, only for those data lists in which data is not represented in a sortable format. In such cases, the specific data retrieval method transforms the data to a sortable format. *Baisley* makes no distinction regarding the sortability of data, but rather only makes a distinction about which data is to be sorted (i.e., the values of the objects that do not have a significant order). Accordingly, *Baisley* does not teach,

show or suggest invoking a specific data retrieval method on the basis of the sortability of data.

The Examiner further suggests that "the step of calling a generic data retrieval method if the data items are sortable in their default format is recited as a conditional step, and is thus not necessarily limiting the claim." The Applicant respectfully submits that this rejection is improper. While Applicant concedes that the Examiner may make the broadest reasonable interpretation of the claims, the Examiner may not read entire elements out of the claim. Any alleged anticipatory reference must necessarily disclose all claimed elements. The Examiner supports his construction of the claim by arguing as follows:

"A critical consideration is the fact that the claimed invention is a set of method steps. The two calling steps are diametrically opposite method steps that only occur under diametrically opposite conditions. Both calling steps cannot occur at the same time, so that the invention cannot be logically composed of both calling steps. One of the steps must therefore be optional."

Respectfully, Applicants submit that the Examiner errs in this rationale. First, it is unclear why the Examiner believes that a "critical consideration" is that the claimed is recited as a method. Applicants are not aware of any legal precedent requiring a different construction of method claims in this regard. Further, the fact that steps are diametrically opposed and occur under diametrically opposite conditions does not logically support the conclusion that the invention cannot be composed of both calling steps and that one of the steps must, consequently, be optional. By the Examiner's logic, for all elements of a method claim to be considered, the steps must be unrelated or occur simultaneously. Applicants submit that no such restriction exists. Respectfully, the Applicants further submit that the Examiner improperly equates conditional steps with optional steps. An optional step is one that need not occur for any reason. A conditional step is one that must occur upon satisfaction of a given condition. Accordingly, Applicants respectfully submit that the Examiner's rejection is improper and should be removed.

The foregoing notwithstanding, Applicant has amended claim 1 in effort to satisfy any concerns the Examiner may have regarding conditionality. Applicant submits that,

as re-written, each element must be considered limiting of the invention. Reconsideration is respectfully requested.

Claims 3, 4, 6, 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, claims 3, 4, 6, 8 and 9 have been rewritten as claims 25-30, respectively and are now considered to be in condition for allowance. It is noted that original claim 6 inadvertently depended from claim 4, instead of claim 5. New claim 27 reflects an appropriate correction of the dependency.

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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